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IN THE

Supreme Court of the United States

OCTOBER TERM, 1966

No. 623

SCOVILL MANUFACTURING COMPANY,

Petitioner,

vs.

GOLDBLATT BROTHERS, INC., and
THE IONA MANUFACTURING COMPANY,

Respondents,

SCOVILL MANUFACTURING COMPANY,

Petitioner,

vs.

CARSON PIRIE SCOTT & COMPANY and
WARING PRODUCTS CORPORATION,

Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

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SUBJECT INDEX

	Page
Petition for Writ of Certiorari	1
Opinions Below	2
Jurisdiction	2
Questions Presented	2- 3
Statutes and Rules	4
Statement of the Case	4- 9
Argument	
Reasons for Granting Petition	9-13
Conclusion	13
Appendix A, Court of Appeals decision	1a- 9a
" " " Dissenting Opinion	8a- 9a
" District Court Memorandum Opinion	10a-14a
Appendix B, Order denying Petition for Rehearing	15a
Appendix C, Orders staying issuance of Mandates	16a-17a

AUTHORITIES CITED

Briggs et al v. M & J Diesel Locomotive Filter Corp. CA 7, 342 F. 2d 573, 144 USPQ 701	13
Deering v. Winona Harvester Works, 155 US 286	12
Hartzell Industries, Inc. v. McCauley Industrial Corporation, CA 6, 304 F. 2d 481, 134 USPQ 275	12
McCullough Tool Company et al v. Well Surveys, Inc., CA 10, 343 F. 2d 381, 145 USPQ 6	13
Mumm v. Decker, 301 U.S. 168, 171, 33 USPQ 247	13
Radio Corporation of America v. Radio Engineering Laboratories, Inc., 293 U.S. 1, 7; 21 USPQ 353	13
U.S. Industrial Chemicals, Inc. v. Carbide and Carbon Chemicals Corporation, 315 U.S. 668, 675-575, 53 USPQ 6, 9	2, 3, 9, 10
Title 28 U.S.C. 1254 (1)	2
Title 35 U.S.C. Sec. 251	4
Title 35 U.S.C. Secs. 271 and 281	4
Title 28 U.S.C. Secs. 1338, 1391, 1400	4
Title 35, Sec. 282	13
Rule 52, Federal Rules of Civil Procedure	4

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Petitioner, Scovill Manufacturing Company, respectfully petitions for a writ of certiorari to the United States Court of Appeals for the Seventh Circuit.

OPINIONS BELOW

The opinion of the Court of Appeals for the Seventh Circuit (Appendix A, infra, pp. 1a-9a) is reported at 362 Fed. 2d 777, 150 USPQ 406. The opinion of the District Court has not been reported but is set forth in Appendix A, infra, pp. 10a-14a, and in the Record below, pp. 378-382.

JURISDICTION

The judgment of the Court of Appeals for the Seventh Circuit was entered July 5, 1966, the date of the decision, Appendix A, infra, pp. 1a-9a. A petition for rehearing was denied August 9, 1966 (Appendix B, infra, p. 15a). The mandate of the Court of Appeals has been stayed until October 14, 1966, to permit the filing of this petition (Appendix C, infra, pp. 16a-17a).

The jurisdiction of this court is invoked under 28 U.S.C. 1254 (1).

QUESTIONS PRESENTED

(1) In a case involving an original and a reissued patent wherein the specifications and drawings are identical and the reissue claims in suit differ from the original claims only in the *omission* of a *description of the form* of one element, but without omission of that element, in which the Court of Appeals for the Seventh Circuit held such omission is "new matter" which renders the reissue claims invalid, did the Court of Appeals decide a federal question in a way in conflict with an applicable decision of this court wherein this court held that a reissue is for the same invention as the original if the reissue describes and claims what constitutes parts or portions of the invention which were intended or sought to be covered or secured by the original patent? (*U.S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corporation*, 315 U.S. 668, 675-676, 53 USPQ 6, 9.)

(2) In this case, involving a two-member coupling for drivingly connecting a pair of separable shafts, in which the original and reissued patents contain identical specifications and drawings, and the reissue claims differ from the original claims only in the *omission* of a description of the *form* of one of the two coupling members, but without omission of that element and without any change in function or mode of operation, did the Court of Appeals for the Seventh Circuit err in holding that "the *unspecified form* of the second coupling member called for in reissue claims 9 to 14 inclusive to complete the coupling means" is "new matter alien to the original patent"?

(3) In a case involving an original and a reissued patent wherein the specifications and drawings are identical, wherein not a single word has been added, and the reissue claims differ from the original claims only in the *omission* of a *description* of the *form* of one element, but without omission of that element, did the Court of Appeals err (a) in ignoring the fundamental principle of patent law that a patent is prima facie valid, and (b) in refusing to accept the district court's findings as to factual issues adopted by the trial court after hearing witnesses on the issue of "same invention"?

(4) In a case where the "presumption of validity" arising from the Patent Office grant of a reissued patent was supported by the findings of fact and conclusions of law adopted by the district court after hearing and observing witnesses, and further supported by the dissenting opinion of one of three Judges of the Court of Appeals for the Seventh Circuit, should not this court review the majority opinion of the Court of Appeals, and give to Petitioner the benefit of this court's decision in *U. S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corporation*, 315 U.S. 668, 675-676, 53 USPQ 6, 9, holding that a reissue is for the same invention as the original if the reissue describes and claims what constitutes parts or portions of the

invention which were intended or sought to be covered or secured by the original patent?

STATUTES AND RULES

The provisions of the Federal Code, Section 251, (Title 35 U.S.C. Sec. 251), and of Rule 52, Federal Rules of Civil Procedure, are relevant. Pertinent parts are the following:

> "Section 251. Reissue of defective patents—Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.
>
> * * *
>
> "No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent."
>
> "Rule 52.—Findings by the Court—(a) Effect. * * * Findings of Fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge the credibility of the witnesses."

STATEMENT OF THE CASE

The basis of federal jurisdiction in the District Court was Title 35 U.S.C. Sections 271 and 281 and Title 28 U.S.C. Sections 1338, 1391 and 1400.

(References herein to the printed record filed in the court below will be to Rec. ....., and to the Exhibit Volume, Exh. Vol. .....)

Reissue Patent No. 24,607, dated February 24, 1959, is a reissue of No. 2,755,900, July 24, 1956, granted to Arthur W. Seyfried, assignor to Petitioner, on an application filed October 16, 1952. The invention relates to flexible coupling means for separable shafts, particularly coupling means for drivingly connecting the motor shaft and the agitator-cutter shaft of motor driven disintegrating food mixers known as blenders.

The Court of Appeals held that if claims 9 to 14 inclusive of reissue patent No. 24,607, in suit, were valid, the record amply supports the district court's findings and conclusions that they are infringed by defendants' accused structures.

The trial court found as fact that the patentee Seyfried is the original, first and sole inventor of the flexible coupling member shown in Figs. 2 and 3 of the drawings of his original and reissued patents (Exh. Vol. 1 and 8), in which the flexible member is described as comprising a centrally apertured rigid disc, a centrally apertured rubber disc having one of its faces vulcanized to one face of the rigid disc, a thickened central portion surrounding said central aperture, and a plurality of flexible teeth integral with the rubber disc on the exposed face thereof, each of the teeth having a contact face perpendicular to the rubber disc and extending radially with respect to the axis of the coupling member between the thickened central portion and periphery of the rubber disc, each tooth being of substantial thickness both radially and circumferentially and having a circumferential surface sloped inwardly from the periphery of the disc to the tip of the tooth and an inclined surface opposite its contact face (Findings of Facts No. 13, Rec. 385,395, adopted by the trial Court, Opinion Rec. 378 at 382 and Appendix A, infra, p. 14a).

Prior to October 16, 1952, the filing date of the original patent, coupling means for coupling shafts in blenders then

on the market were made of metal, resulting in noise, vibration and wear. The invention overcame these difficulties.

Among prior art all metal blender couplings tested by the patentee in January, 1950, were the defendant Waring's blender which was run 3 hours and found "very noisy", and the Oster blender in which the bearing leaked after 37 hours and was very noisy after 3 hours (Rec. 337, 338). The patented coupling overcame the difficulties noted with respect to misalignment, noise and vibration (Rec. 52, 53).

The invention claimed in the original patent claims covered the preferred embodiment of the invention, namely, couplings means for connecting separable shafts comprising one of the described flexible coupling members on each of the two shafts. The patentee had experimented in 1950 with the use of a metal coupling member with a flexible one, Plf. Ex. H and J, and had found such a combination efficient (Appendix A, infra, p. 11a), but he did not specifically claim such alternative coupling in the original application. He believed that his specific flexible member was protected, per se, when he claimed a coupling consisting of two such flexible members (Rec. 332-333); that is, he believed that inasmuch as the use of a flexible member was covered in connection with another similar member, it would be covered when used with a rigid device, as well (Rec. 342-3).

After the issue of the original patent, production difficulties were encountered due to mold defects which caused plaintiff to reject flexible coupling members made by Republic Rubber Division of Lee Rubber & Tire Corp. for plaintiff. These difficulties caused the inventor to consider use of substitute non-flexible materials for one of the two flexible members of the coupling, and to discuss the proposed change with his patent attorney. He was advised that the original claims did not read on the proposed construction, and that his understanding that a patent claim specifying two or more elements would cover each of those elements separately, as well as in combination, was erroneous. There-

upon he promptly applied for reissue of the original patent and submitted claims 9-14 for coupling means including the flexible member defined by the original claims, but not restricted to such a member on each of the two shafts to be coupled together.

When two identical coupling members, such as shown in the patent drawings, Figs. 2 and 3, are used to make the flexible coupling of the patent claims, the rubber tooth surfaces 46 engage each other and the spacing of the teeth radially from the center 45 of the disc 44 permits misalignment without detracting from the driving contact of the engaged teeth. When one such flexible coupling member is used with a non-identical member, such for example as defendants' rigid spoke-wheel form of coupling member, the flexible teeth function in the same manner as when identical flexible members are used together. (Rec. 306, and Findings of Fact No. 15, Rec. 385 and 396).

The patentable novelty of Seyfried's flexible coupling member, per se, has not been questioned (Rec. 292-3).

The specifications of the original and reissue patents are identical (Pl. Ex. A and B, Exh. Vol. pp. 1 and 8). Not a single word has been added to the description of the invention in the reissue. Original claims 1-8 have been repeated in the reissue. Claims 9-14 were added in the reissue.

The original claims cover flexible coupling means for drivingly connecting a pair of separable shafts "comprising a coupling member fixed on each of said shafts" followed by wording defining the novel particular form and construction of the Seyfried flexible member. The reissue claims 9-14 cover coupling means for drivingly connecting said shafts "including a flexible member fixed on one of said shafts" followed by wording similar to the original claims defining the novel particular form and construction of the Seyfried flexible member.

Each of the reissue claims 9 to 14 inclusive calls for

"coupling means for drivingly connecting" a pair of separable shafts. Plaintiff's expert witness testified:

> "This patent disclosure, as embodied in either the original patent or in the reissue patent, is directed to coupling means, and these words, 'coupling means', have a status in this application. Wherever the words or phrase 'coupling means' is used, they are talking about two members. And the patent recognizes that in a coupling means there will be two connecting members.
>
> "The patent then establishes coupling means is equivalent to two members, and then, wherever they are talking about a single unit, they talk about a 'coupling member'.
>
> "Now, this is consistent through the original description and in this present description. And I agree that if you are going to have coupling means you have to have two coupling members." (Rec. 98, 99)

Original claims 1 to 8 inclusive describe the form of each of the two coupling members which constitute the "coupling means", whereas reissue claims 9 to 14 inclusive call for "coupling means" (meaning two members) and describe the form of one of said members.

A description of the *form* of the second coupling member is absent in the reissue claims, but the element, namely, a second coupling member, is expressly called for in the wording "coupling means".

The trial court held:

> "It is apparent that no new matter was introduced into the reissue application within the meaning of Sec. 251. The drawings of the original and reissue patents are materially identical. The specifications of both issues are identical, and the reissue does not contain any new disclosure by way of drawings or description. As stated above, the only difference between the two sets of claims is that the original patent (Claims 1-8) is limited to a coupling which is comprised of a pair of identical coupling members of flexible construction, while the reissue (Claims 9-14) are limited to a coup-

ling which includes one such flexible coupling member without specifying the construction of the second member. The latter apparently falls within the former, and, therefore, no new matter was introduced into the reissue application." (Opinion Appendix A, infra, pp. 10a-14a)

The dissenting opinion of a member of the Court of Appeals stated the same conclusion (Appendix A, infra, pp. 8a-9a).

ARGUMENT

REASONS FOR GRANTING PETITION

The majority opinion of the Court of Appeals applied the decision of this court in *U. S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corporation*, 315 U.S. 668, 675-676, as dispositive of the instant case, on the erroneous premise that the facts in the two cases are analogous. In the cited case, an element was left out of the reissue claims, whereas in the instant case reissue claims 9 to 14 inclusive and the original claims define the same two-member coupling means for drivingly connecting a pair of separable shafts, and differ from each other only in that the *form* of one of the two coupling members is not specified in the reissue claims.

The cited authority would be applicable to the instant case IF one of the two coupling members constituting the "coupling means" in reissue claims 9 to 14 inclusive had been omitted, but the claims call for "coupling means", which include a coupling member of specified form and a second coupling member of unspecified form.

The unanimous finding of infringement of reissue claims 9 to 14 inclusive by the trial court and the Court of Appeals answers in the affirmative any question which may arise as to the equivalency of structure and mode of operation of (1) coupling means consisting of two identical

coupling members having the form shown in Figs. 2 and 3 of the original and reissue patents and called for by the original claims, and (2) coupling means including one coupling member having the form of the member shown in Figs. 2 and 3 and a second coupling member of unspecified form (such, for example, as the rigid second member of defendants' couplers) as called for by reissue claims 9 to 14 inclusive.

The decision of this court in the *U. S. Industrial Chemicals* case dealt with changes in the reissue specification and claims which made the reissue claims cover a *different invention* due to elimination of an essential *element*. In the instant case, only the description of the *form* of an element was omitted in the reissue claims, but the element itself was claimed as part of the two-member coupling means. The Court of Appeals majority opinion treated the *absence* in the reissue claims of descriptive matter relating to the form of the second coupling member as "new matter". The wording of the opinion is as follows:

> "Here the unspecified form of the coupling member called for in reissue claims 9 to 14 inclusive to complete the coupling means is not disclosed in the original patent. It is new matter alien thereto."

Instead of treating non-existent matter, something "unspecified", as new matter, the Court of Appeals should have applied to the instant case the decision of this court that reissue and original patents are for the same invention

> "if the broader claims in the reissue are not merely suggested or indicated in the original specification but constitute parts or portions of the invention which were intended or sought to be covered or secured by the original patent." (*U.S. Industrial Chemicals, Inc. v. Carbide and Carbon Chemical Corporation*, 315 U.S. 668, 675)

In the cited case, the Lefort Reissue No. 20370, Process for the production of Ethylene Oxide, contained a re-

vised specification and differed substantially from the original disclosure and claims which described the voluntary introduction of water into the reaction chamber as a necessary step in the process whereas such introduction was made permissive by the reissue. There was a difference between the compositions and procedure described in the two patents which justified the finding of this court of "new matter". In the instant case, on the contrary, the *omission* of a description of the *form* of the second coupling member did not result in any change with respect to either the number of elements claimed in the reissue or their mode of operation. The trial court and the appeals court agreed that only the claims differ; that the disclosure does not. There is no question as to the novelty and patentability of the flexible member, per se. As the trial court and the dissenting opinion of the Court of Appeals stated, the base invention (the flexible member) was not dependent on the use of two such identical flexible couplers, and, thus, the reissue patent covering the use of only one flexible member with a second member undescribed as to form, covers only matter disclosed in the original patent. While the original claims were limited to a coupling comprising a pair of coupling members of flexible construction, and the reissue was limited to a coupling which *included* one flexible member without specifying the construction of the second member, the latter falls within the former and no new matter was introduced by the reissue application.

Therefore, this case falls within the holding of this court in the cited case that the reissue and original are for the same invention if the reissue claims "constitute parts or portions of the invention which were intended or sought to be covered or secured by the original patent."

The Reissue Statute does not require that the reissue claims shall cover the same invention *claimed* in the original; the purpose of the statute is to allow the patentee to correct his claim by reissue to cover his real invention. The

statute only requires that the invention claimed in the reissue be the same invention *disclosed* in the original. Each and every element of claims 9 to 14 inclusive is fully disclosed in the original.

The Supreme Court of the United States recognized the right of an inventor to claim a subcombination of the invention, by claiming an essential element thereof without specifying another or other cooperating parts. But Seyfried did not exclude a second coupling member from his "coupling means" in claims 9-14, for he said the coupling means includes (but does not consist of) a flexible coupling member. This is analogous to the Elias Howe sewing machine needle, with the eye of the needle near its point, which had no use apart from a sewing machine, concerning which the Supreme Court commented in *Deering v. Winona Harvester Works*, 155 U.S. 286, at page 302, as follows:

> "The invention of a needle with the eye near the point is the basis of all sewing machines used; but the methods of operating such a needle are many, and if Howe had been obliged to make his own method a part of every claim in which the needle was an element, his patent would have been practically worthless."

Likewise, Seyfried had the right to claim "coupling means" including the novel flexible coupling member and a second coupling member not described as to *form*.

A reissued patent is entitled to the same presumption of validity as that given an original patent. Essential to the granting of the reissued patent was the Commissioner's finding that the reissue was for the same invention disclosed in the original, and that the application therefor including the new claims did not introduce new matter. (*Hartzell Industries, Inc. v. McCauley Industrial Corporation*, CA 6th, 304 F. 2d 481, 134 USPQ 275.)

Patent Office validity findings, especially when confirmed by the district court, are not to be overturned by a court of appeals unless clearly infected with error. (*McCullough Tool Company et al v. Well Surveys, Inc.*, CA 10, 343

F. 2d 381, 145 USPQ 6; *Briggs et al v. M & J Diesel Locomotive Filter Corp.*, CA 7, 342 F. 2d 573, 144 USPQ 701.)

The decision of the Court of Appeals made no mention of the presumptive validity of the reissue patent in suit arising from the Patent Office grant, nor of the rule that the burden of establishing invalidity rests on the party asserting it (35 U.S.C. Sec. 282). The presumption of validity is not overcome except by clear and cogent evidence. (*Radio Corporation of America v. Radio Engineering Laboratories, Inc.*, 293 U.S. 1, 7; 21 USPQ 353, 355; *Mumm v. Decker*, 301 U.S. 168, 171, 33 USPQ 247.

Petitioner respectfully submits that the evidence of "new matter" relied on by the majority of the court of appeals was not "clear and cogent" to the degree required for overcoming the presumption of validity based on the Patent Office grant of the patent, supported by the findings of the district court judge who observed and heard the witnesses, and by the dissenting member of the Court of appeals who voted to affirm the district court. The omission of a description of the *form* of a claimed element, without omission of that element, and without any change in specification or drawings, and without any change as to the number of elements claimed or their function or mode of operation, does not justify the finding of the court of appeals that "the unspecified form of the second coupling member" is "new matter".

CONCLUSION

The petition should be granted.

Respectfully submitted,

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APPENDIX A

In the

United States Court of Appeals

For the Seventh Circuit

September Term, 1965 — April Session, 1966

Nos. 15333, 15334
Scovill Manufacturing Company,
Plaintiff-Appellee,

v.

Goldblatt Brothers, Inc., and
The Iona Manufacturing
Company,
Defendants-Appellants.

Scovill Manufacturing Company,
Plaintiff-Appellee,

v.

Carson Pire Scott & Company and
Waring Products Corporation,
Defendants-Appellants.

Appeals from the United States District Court for the Northern District of Illinois, Eastern Division.

July 5, 1966

Before Hastings, Chief Judge, and Schnackenberg and Castle, Circuit Judges.

Castle, Circuit Judge. These appeals involve judgments entered by the District Court following the consolidated

trial of two actions charging patent infringement. The appeal in No. 15333 is prosecuted by Goldblatt Brothers, Inc., and The Iona Manufacturing Company from the judgment order entered in an action in which Scovill Manufacturing Company, the plaintiff-appellee, charges Goldblatt with infringement of claims 9 through 14 of Seyfried's U. S. Reissue Patent No. 24,607 because of the sale by Goldblatt of blenders manufactured by Iona. Iona was permitted to intervene, and with Goldblatt filed answers asserting, inter alia, the invalidity of the reissue claims. The appeal in No. 15334 is by Carson Pirie Scott & Company and Waring Products Corporation from the judgment ordered entered in Scovill's suit charging Carsons with similar infringement because of the sale of a blender made by Waring—in which action Waring was permitted to intervene and with Carsons raised the issue of the validity of the reissue claims. Following trial of the issues the District Court filed a memorandum opinion and made and entered findings of fact and conclusions of law upon which it entered the judgments which are the subjects of these appeals. The court found that claims 9 through 14 of the reissue patent are valid and are infringed by the accused devices manufactured and sold by the defendants.

The subject matter of the patent in suit is a flexible coupling means for separable shafts, particularly such a means for operatively connecting the armature and agitator shafts of motor driven disintegrating food mixers also known as blenders or liquidizers. The record discloses that the original patent, Seyfried U.S. Patent No. 2,755,900, issued July 24, 1956 on an application filed October 16, 1952, and contained eight claims. The Reissue Patent No. 24,607, issued February 24, 1959, added claims 9 through 14, the claims in suit. Scovill is the owner of the patent by assignment.

The drawings and descriptions of the original and reissue patents are identical with one minor exception

not here pertinent. The reissue patent differs from the original only in that it adds claims 9 through 14.

A factor common to all of the eight claims of the original patent is that each calls for a "flexible coupling means for drivingly connecting a pair of separable shafts" and "comprising a coupling member fixed on each of said shafts". The remaining language of each of these claims includes a detailed description of the form and shape of the flexible (preferably rubber) toothed member. And the specification recites that in referring to the drawings illustrating the flexible coupling members "it will be understood that these members are identical but one is mounted on the armature shaft with its teeth upwardly directed and the other is mounted on the agitator shaft with its teeth directed downwardly, engaging each other when the parts are in operative position." The claims and specification additionally disclose that the two identical coupling members which form the claimed "flexible coupling means" are shaped to be co-operatively interfitting, "the teeth of each member being spaced apart circumferentially to receive between them the teeth of the other coupling member when said members are in driving relationship", with the contact faces of the teeth of one member designed to register in maximum face area contact with the contact faces of the teeth of the corresponding member when the shafts are brought into alignment.

The factor common to claims 9 to 14 inclusive of the reissue patent, and which serves to distinguish them from claims 1 to 8 inclusive, is the introductory language of each of the added claims:

> "In combination with a pair of separable shafts which are longitudinally and laterally movable relatively to each other, coupling means for drivingly connecting said shafts including a flexible coupling member fixed on one of said shafts comprising . . . etc.

There follows in each of the added claims a description of

the form and shape of such flexible member including details with respect to the contact face and the various inclined surfaces of the flexible toothed member in substantially the same language of a corresponding original claim but omitting the use of terminology which would indicate or call for the presence of an identical reciprocal member on the other shaft. Thus claims 9 to 14 inclusive do not define or describe in any manner the other coupling member which together with the flexible member described is to form the "coupling means" claimed. These added claims however do remove the limitation that the second coupling member, which together with the flexible member described is to form the "coupling means for drivingly connecting" the two shafts, be an identical flexible coupling member as is required in claims 1 to 8 inclusive. This broadens and enlarges the scope of the claims of the original patent.

Although other related and subsidiary issues are the subject of contentions made by the parties, we conceive the main contested issue presented on appeal to be whether the reissue claims 9 to 14 inclusive are "for the invention disclosed in the original patent", although not fully claimed therein, and therefore authorized by 35 U.S.C.A. 251.[1]

On this phase of the case the District Court found that the patentee Seyfried had been under the erroneous impression that a patent claim specifying two or more elements would cover each of those elements separately, as well as in combination, and that his original patent claims would cover his flexible coupling whether he used one or two of the flexible members in the coupling; through this error he claimed less than he was entitled to claim in his original

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[1] 35 U.S.C.A. 251 provides in pertinent part:

> "Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid . . . by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, . . ."

patent; the reissue claims 9 to 14 inclusive define the invention which the patentee intended to protect when he applied for his original patent; and that claims 9-14 of the reissue "cover the same invention as that disclosed in the original patent". The court concluded that the reissue patent covering the use of only one flexible member covers only matter disclosed in the original patent.

But neither the documentary evidence consisting of the patent claims, drawings and specification, nor the testimony of the expert witnesses support the court's finding that the reissue claims are confined to the invention disclosed in the original patent. As heretofore stated, the specification of the original patent required that it be understood that the coupling members "are identical". The plaintiff's expert witness, Charles B. Messenger, admitted that there is no reference any place in the specification to a different coupling member—any member other than the two co-operating members shown in the patent—for use with one of the coupling members shown in the patent; that there is no reference to two members to form a coupling means, where the members may be different; and that there is no reference to the use of a flexible coupling member with a rigid member to form the coupling means.[2] Defendants' expert witness, Carlton Hill, testified that the objects set forth in the original patent were to provide a separable flexible coupling means, which when coupled, would be self-finding, which would take care of any misalignment of the shafts and would eliminate vibration and noise, and that:

> "In my opinion, the contribution made by Seyfried was the provision of a flexible coupling having identical teeth mating with each other, of a particular and specific configuration.

---

[2] The defendants' accused structures held to infringe the reissue claims 9 to 14 inclusive are coupling means in which one member is a flexible coupling member of the type described in the claims but the other is a rigid member of metal or plastic, cup-like in design, with spoke-like radial vanes with which the teeth of the flexible member engage.

The configuration having been worked out in such a way that the identical teeth would give a maximum of co-operation.

Now, the contribution could have been no more than that because rubber couplings, flexible couplings, were old for the exact purposes that the patentee Seyfried stated. They were made in various forms.

The few patents I have discussed are examples of that. Therefore, as of the time Seyfried entered the field, the scope or extent of his contribution was the very limited one of the particular tooth form, and more importantly the co-operation between mating pairs of those teeth.

* * * * *

My opinion is that they (reissue claims 9 to 14 inclusive) were not validly added because they are for an invention not disclosed—or purport to be for an invention not disclosed in the original patent.

And I perhaps should explain that. The whole concept of the original patent were these mating pairs of peculiarly shaped teeth and identical teeth, one pointing one way and one the other. There wasn't a word in the original patent, and I found none in the original file wrapper directed to use of one of these coupling members with anything other than an identical coupling member."

In addition to the documentary evidence afforded by the patent claims drawings and specification which speak for themselves, the agreement in the testimony of the opposing experts that the original patent disclosed only the use of identical flexible coupling members to form the "coupling means" claimed therein makes it evident that the finding of the District Court that the added re-issue claims are confined to the disclosures of the original patent is clearly erroneous.

The reissue claims dispense with the limitation of a pair of identical flexible coupling members called for by the original patent and attempt to broaden the scope of the patent to include a coupling means which includes but one

of the flexible members described in the original claims 1 to 8 inclusive, in combination with an unspecified form of a second co-operating coupling member which is undisclosed either generically or specifically in any manner by the original patent. By omission of the limitation requiring the presence of two identical flexible members to form the coupling means and thus extending reissue claims 9 to 14 inclusive to the use of but one such member the patentee in effect interpolated a new feature—the unspecified form of a second co-operating coupling member—neither described, suggested, nor indicated in the original patent. And, as early as 1887 it was pointed out in Parker and Whipple Company v. Yale Clock Co., 123 U.S. 87, 98, that "(l)etters-patent reissued for an invention substantially different from that embodied in the original patent are void and of no effect".

In a more recent decision regarding reissue patents, which in our opinion is dispositive of the instant case, U. S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corporation, 315 U.S. 668, 675-676, it is observed:

> "The question is whether, in the light of the disclosures contained in the two patents, they are for the same invention. . . . If there be failure of disclosure in the original patent of matter claimed in the reissue, it will not aid the patentee that the new matter covered by the reissue was within his knowledge when he applied for his original patent."

Here the unspecified form of the second coupling member called for in reissue claims 9 to 14 inclusive to complete the coupling means is not disclosed in the original patent. It is new matter alien thereto. Thus, reissue claims 9 to 14 inclusive call for a different combination of coupling members—not for the same invention disclosed in the original patent.

We conclude that the District Court erred in holding

reissue claims 9 to 14 inclusive valid. They are invalid, and there can be no infringement[3] of invalid claims. Toro Manufacturing Corporation v. Jacobsen Manufacturing Company, 7 Cir., 357 F.2d 901, 904; Enterprise Railway Equipment Co. v. Keystone Railway Equipment Co., 7 Cir., 267 F.2d 102; Simmons Company v. Hill-Rom Company, 7 Cir., 352 F.2d 886.

In each of the appeals the judgment order of the District Court appealed from is reversed.

Reversed

Circuit Judge Schnackenberg, dissenting.

With deference to Judge Castle, I find myself in disagreement with the result which he has reached in his opinion. I would affirm the judgment of the district court, for the following reasons, inter alia:

Seyfried, by his patent No. 2,755,900 covering flexible coupling means for drivingly connecting the motor shaft and agitator shaft in food mixers, introduced flexible rubber couplers to overcome vibrations and poundings at the bearings. Having claimed only the use of two flexible members together and not specifically claiming, alternatively, the use of a single flexible member with a metal or non-flexible member, Seyfried applied for a reissue patent, which was issued as No. 24, 607. The validity of the latter is involved in this case.

I agree with the district court that Seyfried's reissue patent covers the same invention described in the original. Although the claims vary, the disclosure does not. The only difference is that while Seyfried originally claimed the use of the flexible member in connection with another like coupler, in the reissue he claims only the flexible member itself.

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[3] If the claims were valid the record amply supports the District Court's findings and conclusions that they are infringed by defendants' accused structures.

The base invention (the flexible member) was not dependent on the use of two such identical flexible couplers, and, thus, the reissue patent covering the use of only one flexible member covers only matter disclosed in the original patent. Neither by specifications or disclosures by way of drawings or otherwise are the original and reissue patent other than identical. While the original patent was limited to a coupling comprising a pair of coupling members of flexible construction, and the reissue was limited to a coupling which included one flexible coupling member without specifying the construction of the second member, it is apparent that the latter falls within the former, and so no new matter was introduced by the reissue application. This falls within the purpose of the reissue statute and does not constitute an "addition of new matter." The patentee should not be penalized for claiming too narrowly in the original patent. Moreover, there is no proof of sales of defendants' coupling device before the reissue patent was granted, thus no intervening rights run directly to defendant.

I would affirm the judgment of the district court that the reissued patent and the claims therein are valid and infringed by defendants.

A true Copy:

Teste:

Clerk of the United States Court
Appeals for the Seventh Circuit.

APPENDIX A

IN THE UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

SCOVILL MFG. CO.
Plaintiff,
vs.
GOLDBLATT BROS., et al.,
Defendants.
No. 61 C 1294

SCOVILL MFG. CO.
Plaintiff,
vs.
CARSON, PIRIE, SCOTT & CO., et al.,
Defendants.
No. 61 C 1295

MEMORANDUM OPINION

For Decision—

It would appear that prior to the issuance of Patent No. 2,755,900, on July 24, 1956, to Arthur W. Seyfried, covering *flexible* coupling means for drivingly connecting the motor shaft and agitator shaft in food mixers, those blenders on the market employed *all metal* couplers, which were noisy, caused vibrations, and pounded at the bearings. (Tr. pp. 608-610; 611-617). The "invention" overcame these difficulties by introducing flexible rubber couplers.

The original Patent (Claims 1-8), however, claimed only the use of two flexible members together, and did not specifically claim, alternatively, the use of a single flexible member with a metal, or non-flexible one. Realizing this omission, Plaintiff thereafter filed an application for a re-

issue patent, which was issued on February 24, 1959, as U.S. Reissue No. 24,607. The validity of said Reissue Patent is the main point of contention in the action before us.

Section 251, Title 35, U.S.C., provides for reissue when (1) the original patent, through error, without deceptive intention, was partly defective by reason of the patentee claiming less than he had a right to claim; (2) the reissue covers the same invention disclosed in the original; (3) no new matter was introduced into the application; and (4) the application was filed within two years from the grant of the original patent.

The record indicates that the Patentee had experimented in 1950 with the use of a metal member along with the flexible one, (Pl. Ex. H and J) (Tr. p. 613 et seq.), and had found such a combination efficient. It is further indicated that such alternative coupling structure was not *specifically* claimed in the original application because the patentee believed that it was included automatically when he claimed the use of two flexible members, (Tr. pp. 606, 607). That is, he believed that inasmuch as the use of a flexible member was covered in connection with another similar member, it would be covered when used with a rigid device, as well. (Tr. pp. 624, 625).

In light of the patentee's apparent lack of understanding with regard to the legal significance of patent claims, (Tr. pp. 624-625) and the unquestioned novelty of the individual flexible coupling member per se, (Tr. pp. 526-527), the first requirement of Sec. 251, Title 35, U.S.C. would seem to have been met.

Secondly, it would appear that the reissue patent covers the same invention described in the original. While the *claims* vary, the *disclosure* does not, and this is the crucial test. Each structural element of the flexible coupling member is clearly described in the original patent. The only difference is that while the Patentee originally claimed the use of the flexible member in connection with another like

coupler, in the reissue he claims only the flexible member itself. The base invention (the flexible member) was not dependent on the use of two such identical flexible couplers, and, thus, the reissue patent covering the use of only one flexible member covers only matter disclosed in the original patent.

It is apparent further that no new matter was introduced into the reissue application within the meaning of Sec. 251. The drawings of the original and reissue patents are materially identical. (Pl. Ex. A & B). The specifications of both issues are identical, and the reissue does not contain any new disclosure by way of drawings or description. As stated above, the only difference between the two sets of claims is that the original patent (Claims 1-8) is limited to a coupling which is comprised of a pair of identical coupling members of flexible construction, while the reissue (Claims 9-14) are limited to a coupling which includes one such flexible coupling member without specifying the construction of the second member. The latter apparently falls within the former, and, therefore, no *new* matter was introduced into the reissue application. That is, in the reissue, the patentee eliminated wording in the original claims, which deprived him of the protection he was entitled to receive, but did not claim through error. This is the purpose of the reissue statute, and does not constitute the "addition of new matter." See *Deering v. Winona Harvester Works*, 155 U.S. 286. Inasmuch as the flexible coupling member itself was novel and useful, it would be unjust to limit the patentee's protection to use of it in the method described in the original patent. The patentee should not be so penalized for his error of claiming too narrowly in the original patent.

Finally, the record indicates that the patentee applied for the reissue sixteen months after the original patent issued, and within a few weeks after he discovered his error. The error here was a technical one, and involved

interpretation of "claims." The patentee could not be expected to have realized his mistake from the face of the Patent, and when the error became known to him, he was diligent in applying for a reissue within the two year statutory period.

Thus, it would seem established that the reissue patent meets the requirements and purposes of Sec. 251, Title 35, U.S.C.

The prior art relied on by defendants to invalidate the Patent is not in point. Indeed defendants' own activity in copying plaintiff's device although seven of the eight "prior art" patents had expired and were freely available, gives weakness to their position. See *Diamond Rubber Co. v. Consolidated Rubber Co.*, 220 U.S. 428, 441.

The structural differences between the prior art couplings and the patented device were described by plaintiff's expert witnesses at pp. 581-588 of the transcript. Defendant was unable to effectively counter this evidence. The Patent is prima facie valid, and the burden must fall on the defendants to prove otherwise. This burden, they have failed to sustain.

The testimony on pp. 74-75 of the transcript reveals that defendants, for all practical purposes, concede that if the patent is found valid, infringement is present. Indeed, visual inspection of defendants' coupler, demands the same conclusion, that the Claims of the reissue patent are embodied in the accused coupling. (See Tr. pp. 91-102). The defendants have utilized a coupling means including two members, one of which is flexible and embodies the major structural features of the reissue patent, and the other of which is rigid. Having found the reissue to be valid, supra, and to cover the use of the flexible member with any other form of coacting member, it is apparent that defendants here are guilty of infringement.

Much testimony was taken in regard to defendants'

claim that a blender embodying a flexible member was sold by DeWenter Industries, Inc. under the name Blendal, prior to the filing of the reissue application. If this is so, intervening rights may be established by DeWenter, pursuant to Sec. 252, Title 35, U.S.C. But such intervening rights, if merited, would enure only to the owner of such rights, and not to defendants here. *City of Milwaukee v. Activated Sludge Inc.*, (7th Cir.,) 21 U.S.P.Q. 69, 84-85; of course, if the Patentee was aware of the Blendal mixer before he filed for reissue, such knowledge might have bearing on the motive behind the application. The record, however, reveals no evidence of prior knowledge to contradict the patentee's assertions that he first saw the Blendal mixer in 1958 after he filed his reissue application.

Similarly, the defendants have failed to prove the making of sales (or substantial preparation therefor) of their *own* coupling device before the reissue patent was granted. Thus, we can find no intervening rights running directly to defendants.

Accordingly, it is the judgment of this Court that the reissue patent and the claims therein are valid, and infringed by defendants. We shall, therefore, adopt the detailed findings of fact and conclusions of law submitted by plaintiff and plaintiff will submit an order to this effect within five (5) days.

ENTER:

ABRAHAM L. MAROVITZ
Judge

Dated: June 18, 1965

APPENDIX B

United States Court of Appeals

For the Seventh Circuit

Chicago, Illinois 60604

Tuesday, August 9, 1966

Before

Hon. JOHN S. HASTINGS, Chief Judge

Hon. ELMER J. SCHNACKENBERG, Circuit Judge

Hon. LATHAM CASTLE, Circuit Judge

Scovill Manufacturing Company,
Plaintiff-Appellee

No. 15333, 15334

vs.

Goldblatt Brothers, Inc., et al, and Carson, Pirie, Scott & Company, et al,
Defendants-Appellants

Appeals from the United States District Court for the Northern District of Illinois, Eastern Division.

IT IS ORDERED by the Court that the plaintiff-appellee's petition for rehearing be, and the same is hereby DENIED.

(Judge Schnackenberg voted to grant a rehearing.)

APPENDIX C

United States Court of Appeals

For the Seventh Circuit

Chicago, Illinois 60604

Monday, August 15, 1966

Before

Hon. LATHAM CASTLE, Circuit Judge

No. 15333, 15334

SCOVILL MANUFACTURING COMPANY,
Plaintiff-Appellee

vs.

GOLDBLATT BROTHERS, INC., et al,
Defendants-Appellants

Appeals from the United States District Court for the Northern District of Illinois, Eastern Division.

On consideration of the motion of counsel for plaintiff-appellee, IT IS ORDERED that the issuance of the mandates of this court be stayed for a period of thirty (30) days from this date in accordance with the provision of Rule 28 of the Rules of this Court.

APPENDIX C

United States Court of Appeals

For the Seventh Circuit

Chicago, Illinois 60604

Wednesday, August 31, 1966

Before

Hon. LATHAM CASTLE, Circuit Judge

No. 15333, 15334

SCOVILL MANUFACTURING COMPANY,
Plaintiff-Appellee

vs.

GOLDBLATT BROTHERS, INC., et al,
Defendants-Appellants

Appeals from the United States District Court for the Northern District of Illinois, Eastern Division.

On consideration of the motion and affidavit of counsel for plaintiff-appellee, counsel for defendants-appellants having filed no objections thereto,

IT IS ORDERED that the issuance of the mandates of this Court be further stayed to and including October 14, 1966, in accordance with the provisions of Rule 28 of the Rules of this Court.